

## REMARKS

In response to the Office Action dated September 22, 2010, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims.

### **35 USC § 101**

Claims 7-9 and 25 were rejected under 35 USC § 101, on the grounds that they were considered to encompass transitory subject matter, such as a signal. To remove this issue and thereby expedite examination, independent claims 7 and 25 have been amended pursuant to the examiner's suggestion, to recite that the claimed computer-readable medium is "non-transitory". Withdrawal of the rejection is respectfully requested.

### **35 USC §§ 102 and 103**

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16 - 19, and 22 - 27 are rejected under 35 U.S.C. § 102(e), on the basis of US 6,873,426, hereinafter *Farrell*. Claims 3, 6, 9, 12, 15 and 20 were rejected under 35 USC 103(a) on the basis of *Farrell* in view of *Jeyachandran* (US 6,567,176). Claim 21 was rejected on the basis of *Farrell* in view of *Jeyachandran* and *Trovinger* (US 6,708,967).

In view of the foregoing amendments and the following discussion, it is respectfully submitted that the applied references do not teach or suggest the claimed subject matter to a person of ordinary skill in the art, whether considered individually or in combination.

Summarizing Applicants' previous arguments, claim 1 recites, among other features, that finishing specifics are separated into two groups, one group to be performed by an on-line printer and a second group to be performed by an off-line finishing device. In contrast, *Farrell* only discloses that one device is operative to

perform finishing, i.e., the finisher 18. The print module 34 has no finishing capabilities. Furthermore, according to *Farrell*, if the finisher 18 cannot perform the assigned finishing specifics, the finishing specifics are changed to alternative or substitute specifics.

*Farrell* does not disclose a printing system that stores information about an on-line printer and a distinct, i.e., off-line, finishing device, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus, the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9 - 22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

While Applicants maintain that claim 1 as previously presented was patentably distinct from the disclosure of the *Farrell* patent, to further elucidate these distinctions claim 1 has been amended to explicitly recite that first and sets of finishing specifications, which are respectively capable of being performed by the on-line printer and the off-line finishing device, are stored. For example, Figure 7 of the application illustrates one example of a table that stores respective sets of finishing capabilities for the printer and the off-line finisher.

Amended claim 1 further recites that the sorter separates the finishing specifics in the job ticket into finishing specifics selected from the stored first set that is capable of being performed by the on-line printer, and finishing specifics selected from the stored second set that is capable of being performed by the off-line finisher. The finishing specifics selected from the stored first and second sets are then respectively assigned to the printer, to be performed, and to the finisher, to be performed. Thus, with continued reference to the example of Figure 7, the sorter has selected the double-speed imposition and two-sided printing from the set of specifications stored for the printer, and assigned them to be performed by the printer, as indicated by the shading. From the set of specifications and options stored for the finishing device, it has selected two-place stapling, folded binding and thick red paper, and assigned them to be performed by the finishing device.

It is respectfully submitted that the system of the *Farrell* patent does not anticipate, nor otherwise suggest, the claimed subject matter. First, it does not store in memory first and second sets of specifications that respectively correspond to the capabilities of an on-line printer and an off-line finishing device. At best, the print controller only has knowledge of the capabilities of the printer.

Second, it does not separate finishing specifics in a job ticket into two groups that respectively comprise (i) finishing specifics selected from a stored first set corresponding to the capabilities of the printer, and (ii) finishing specifics selected from a stored second set corresponding to the capabilities of an off-line finisher. To the extent that the *Farrell* patent suggests separation into two groups, those groups respectively comprise the functions that **can** be performed by the printer, and those functions that **cannot** be performed by the printer. Nowhere does the *Farrell* patent

suggest that the substitute literal finishing or the substitute abstract finishing (described at column 4, lines 12-20) is based upon a set of stored capabilities of an off-line finisher. In fact, the print controller of the *Farrell* patent is not described as having knowledge of the capabilities of any particular off-line finishing device. All of its actions are based solely upon the capabilities of the printer. The substitute abstract finishing only provides a representation of "desired" finishing instructions, to make later off-site finishing "more likely" to agree with the original intended instructions. These statements indicate that the controller does not have knowledge whether any given finishing device does, in fact, possess the capability to perform the desired finishing.

For at least these reasons, the *Farrell* patent does not support a rejection based upon anticipation, since it does not disclose **every** feature recited in claim 1. If the rejection is not withdrawn, the examiner is respectfully requested to explain, with particularity, where the *Farrell* patent discloses:

- (1) storing first and second sets of finishing capabilities that are respectively associated with an on-line printer and an off-line finisher; and
- (2) separating finishing specifications in a job ticket into (a) those specifics that are *selected* from the stored first set of capabilities and (b) those specifics that are *selected* from the stored second set of capabilities.

In the absence of such a showing, it is respectfully submitted that proper support for the rejection based on anticipation has not been established.

Independent claims 4, 7, 10, 13, 16, 22 and 24-26 have been amended in a manner analogous to claim 1, and recite the distinguishing features discussed above. As such, these other independent claims are likewise not anticipated by the

*Farrell* patent. For at least these same reasons, dependent claims 2, 5, 8, 11, 14, 17-19, 23 and 27 are also not anticipated.

Claims 3, 6, 9, 12, 15, 20, and 21 are rejected under 35 USC 103(a) on the basis of the *Farrell* patent in combination with U.S. patent No. 6,567,176, hereinafter *Jeyachandran*. For claim 21, U.S. Patent No. 6,708,967, hereinafter *Trovinger* is also used in the rejection. However, the features relied upon from *Jeyachandran* do not overcome the deficiencies set forth above with regard to *Farrell*.

With regard to *Trovinger*, the Office Action asserts that the finishing device is an off-line device. However, that also does not overcome the fact that *Farrell* does not teach or suggest the distinguishing features identified above. Accordingly, neither *Jeyachandran* nor *Trovinger* overcome the inability of *Farrell* to support a rejection of the claims.

For the foregoing reasons, it is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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